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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,900	08/27/1999	ALVARO J. LAGUNA	MP/147	8440

7590 08/26/2002

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EXAMINER

THISSELL, JEREMY

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary

Application No.

09/384,900

Applicant(s)

LAGUNA ET AL.

Examiner

Jeremy T. Thissell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/29/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Interview Summary / Request for Reconsideration

In view of the arguments discussed in the interview summary on 22 May 2002 (paper No. 11) and set forth in the request for reconsideration filed 29 May 2002, the Examiner hereby withdraws the finality of the previous rejection rendered on 6 March 2002.

However, the examiner regrets to inform that an updated search has turned up a new applicable reference. Despite discussions during the interview of claims being allowable over the prior art *of record*, new rejections have been rendered with new art. This office action has accordingly been made **NON-FINAL**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

Claims 24-26, 29, 32, 37, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Glickman (US 5,919,163).

Glickman teaches all the claimed subject matter including a piece of tubing made out of elastomeric material (col. 16, lines 43-52), which is positioned on a catheter shaft to form a balloon which is slidable along the shaft while maintaining a "fluid tight seal" (claim 8). The fact that the ends of the balloon remain tight against the catheter shaft but are movable along it, indicates that they are non-distensible as compared to the rest of the balloon, and that the balloon is a separate piece of equipment that maintains those properties of distensibility even when not mounted on a catheter. Glickman also teaches attachment of the balloon to the catheter with adhesive (col. 16, lines 46-48).

Instant claims 29 and 37 are product by process claims and thus the process (thermally treating) is not given patentable weight. With regard to claims 32 and 40, Glickman meets the limitations of these claims since it teaches a balloon with non-distensible ends, attached to a non-distensible catheter via adhesive (col. 16, lines 46-48; element 108 on slidable balloon 110 can be adhesively attached to catheter shaft).

Claims 24-30, 35-38, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ravenscroft et al. (US 5,766,201).

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Ravenscroft teaches all the claimed subject matter including a sleeve having an expandable part and a non-expandable part, due to a strip or wrapping. See col. 1, line 66 – col. 2, line 35.

Claims 28, 29, 36, and 37 are product by process claims and although the claims are definite according to 35 USC 112 2nd paragraph, no patentable weight is given to the process by which the device was made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 34, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glickman (US 5,919,163) in view of Campbell et al (US 5,868,704).

Glickman teaches all the claimed subject matter except for the sleeve being made out of a fluoropolymer. Campbell teaches a balloon made out of polytetrafluoroethylene (claims). Fluoropolymers such as polytetrafluoroethylene (PTFE) are well-known to be used to make catheters, as illustrated by Campbell. It would have been obvious to use PTFE to make the sleeve of Glickman, since it would perform equally as well as the disclosed material. Also note that both Glickman and Campbell teach that a possible alternative material that can be used to form the balloon is

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polyurethane (Glickman, col. 16, line 46; Campbell, col 3, line 26). Again, materials such as PTFE, polyurethanes, and polyethylenes are extremely common in the art of catheters/balloons.

Claims 28, 30, 31, 36, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glickman (US 5,919,163) in view of Crocker et al (US 5,843,116).

Glickman teaches all the claimed subject matter except for the sleeve being coated on the ends or having a collar on the end to render the end non-distensible. Crocker teaches a balloon sleeve with a collar (40/44) to limit expansion. Crocker also teaches that alternative means can be used to limit expansion, such as coatings (col. 5, line 55-58). Since Glickman makes no mention of *how* his balloon ends are made to be non-distensible, it would have been obvious to one of ordinary skill in the art to use collars or coatings in the manner set forth by Glickman to render the balloon ends of Glickman non-distensible as these are equivalent for their use as such and the device would work equally well with any of these structural designs. To further support this point, Applicant discloses that any of these expansion-limiting elements can be used to form the instant invention. Applicant's claims and specification basically set forth all the different ways that one could reasonably render the ends of a distensible tubular structure to be non-distensible.

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Claims 27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glickman and Crocker as applied to claims 24 and 25 above, and further in view of Ravenscroft et al (US 5,766,201).

Glickman as modified by Crocker teaches all the claimed subject matter except for tape wrapping the ends of the tubing to render it non-distensible. Ravenscroft teaches tightly wound tape wrapping at the ends of the balloon to render it of a different distensibility than the rest of the balloon (see fig. 1 and col. 1 line 67 – col. 2, line 5). Due to the interchangeability discussed supra and the lack of a teaching in Glickman of how he makes the ends of his balloons non-distensible, one of ordinary skill in the art would have found it obvious to use the tape wrapping of Ravenscroft to render the ends of the Glickman balloon non-distensible.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

This action is being made **NON-FINAL** in view of new grounds of rejection.

Contacts

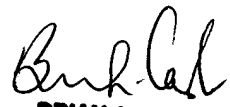
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy T. Thissell whose telephone number is (703) 305-5261. The examiner can normally be reached on 8:30-7:00 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached at (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 306-45209303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jt

August 15, 2002


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700